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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,076	01/10/2002	Osamu Nagai	P67506US0	1981
136	7590	08/12/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/030,076	NAGAI ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 July 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 23-40 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

This is in response to Papers filed on 27 July 2004.

- A. The record shows that applicants and their counsel did not update the claim record for a proper and timely consideration, search and examination before an Office action on the merits is made.
- B. An amendment to the abstract on 10 June 2004 is entered and considered only. Others are improperly and separately labeled and paid fee for foreign description after an Office action on the merits. Applicants and their counsel also improperly submit claims 23 and 24 only but fail to properly submit a claim set amendment. They are not considered. No improper step, discussion or suggestion is on the record.
- C. The record shows that applicants and their counsel have to make an amendment in response to the Office action on the merits on the record. It would result in
  - (1) next examination Office action would be properly made final,
  - (2) no refund fee for an extension time would be considered or done,
  - (3) a restriction is properly made.
- D. Applicants and their counsel state on the record that there is no new matter of any embodiment in the amendment being added. It is acknowledged. Applicants and their counsel fail to precisely and exactly provide support for each of the amended embodiments by showing

page and line in the original filed specification for a proper and timely consideration.

Accordingly, if a new matter is found, please see the authority stated in Tronzo v. Biomet Inc., 4 USPQ2d 1403.

E.1. Claims 23-40 are generic to a plurality of disclosed patentably distinct species comprising gasket lips being on (1) graphite plate, (2) groove surface and (3) groove in electrode. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

2. Claims 23-40 are generic to a plurality of disclosed patentably distinct species comprising gasket lips having (1) one lip and (2) two lips. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

3. Claims 23-40 are generic to a plurality of disclosed patentably distinct species comprising gasket lip being on (1) graphite plate, (2) groove surface and (3) groove in electrode. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

4. Claims 23-40 are generic to a plurality of disclosed patentably distinct species comprising gasket being (1) in connection with a pair of electrodes clamps an electrolyte membrane portion in between and (2) connection hole in the substrate. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

5. Claims 23-40 are generic to a plurality of disclosed patentably distinct species comprising (1) first and second seal portions are arranged...to clamp said electrolyte membrane portion in between and (2) a coupling portion adapted to be secured...as those of said first and second gasket lips. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

6. Claims 30-38 are generic to a plurality of disclosed patentably distinct species comprising steps (1) two opposite inner...to each other in a fuel battery and (2) two opposite surfaces of a substrate...in a battery. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

7. Claims 23-40 are generic to a plurality of disclosed patentably distinct species comprising steps (1) deposit one of say pair of electrodes... and (3) forming a connection hole.... Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

F. The record shows that none of the amended claims has been considered or searched.

G. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 23-26, drawn to a gasket, classified in class 277, at least subclass 606+.
  - II. Claims 27-29, drawn to another patentably different and distinct type of gasket than that in "I" above, classified in class 277, at least subclass 613+.
  - III. Claims 39-40, drawn to another patentably different and distinct type of gasket than those in "I" and "II" above, classified in class 277, at least subclass 622+.
  - IV. Claims 30-34, drawn to processing steps of making a gasket, classified in class 264, at least subclass 14+. If applicants elect this invention, the application may be transferred.
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- II. Claims 35-38, drawn to another processing steps of making a gasket those in "IV" above, classified in class 264, at least subclass 524+. If applicants elect this invention, the application may be transferred.

The inventions of Groups I, II and III are all related to the materials but have the patentably different and distinct types and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

The inventions of Groups I, II and III are all related to the materials but have

the patentably different and distinct steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions of Groups (I, II and III) and Groups (IV and V) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the gasket as claimed can be made by another and materially different process other than the injection molding process as claimed. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or

provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

H. An additional consideration or search for more than one invention, class or subclass in the art is burdensome, lacks of focus on many and all issues in the claimed inventions and dilutes patentability of many and all issues in many inventions than those in one. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

I. Applicant is advised that the reply to this requirement to be complete must include a proper and full election as set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

J. However any process claim is permitted to be rejoined with an elected material claimed Invention provided (a) that the material claimed invention is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

K. Other issues have not been considered until a proper election is made and resolved all of the requirements as clearly pointed out and set forth above.

L. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
09 August 2004

HOA VAN LE  
PRIMARY EXAMINER

